III. REMARKS/ARGUMENTS

A. Status of the Claims

Claims 1-31 are pending. Claims 14, 19, 26, 27 and 31 have been amended. No new matter is introduced by these amendments, and these amendments are fully supported by the specification. Applicant respectfully requests reconsideration of the rejections of these claims for at least the following reasons.

B. Claim Rejections under 35 U.S.C. § 101

Claims 1-31 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Specifically, with regard to claims 1-13, the Office Action asserts:

> Applicant recites "A system … comprising:", however, there does not appear to be any computer related hardware or devices or specific structure in the body of the claim. Applicant recites "receiving unit", "interface", "consumer database", and "suppression database" in the body of the claim. A "receiving unit" and an "interface" are defined as software that enables a program to work with a user and a "database" is computer program for managing electronic data which are software. Software alone in an apparatus claim prevents the claim from falling into one of the statutory categories of invention (see MPEP 2106.01).

Office Action, Page 3. Applicant respectfully disagrees, as there is no support for the Office Action's assertion that a "receiving unit" and an "interface" are "defined as software." If the Office Action is citing the specification as the source of this "definition," Applicant respectfully requests that a citation be provided. Otherwise, Applicant submits that the receiving unit and the interface are hardware.

Similarly, there is no support for the Office Action's assertion that a database is a "computer program for managing electronic data which [is] software." *Id.* A database stores data on a medium. A database is implemented on

hardware. As such, Applicant respectfully requests that this rejection be withdrawn.

The Office Action continues:

> Claim 3 is rejected under 35 U.S.C. 101. Applicant recites "a human operator" which is not a system and does not fall into one of the four statutory categories of invention (see MPEP 2106.01).

Id., Page 4. Applicant notes that MPEP 2106.01, cited in the Office Action, does not preclude the claiming of a "human operator." Therefore, Applicant respectfully requests that this rejection be withdrawn.

With regard to claims 14-31, the Office Action recites:

> Claims 14-31 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Here, Applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 14-31 are non-statutory since they may be performed within the human mind.
>
> The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion *Ex parte Langemyr*.

Id. (citations omitted). Although Applicant does not necessarily agree with this rejection, in an effort to expedite the prosecution of the present application, Applicant has amended the claims appropriately.

C. <u>Claim Rejections under 35 U.S.C. § 112, ¶ 2</u>

Claims 3-4 stand rejected under 35 U.S.C. § 112, ¶ 2, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts:

> Claim 3 recites the first interface unit is "a human operator" but claim 4 recites the first interface unit is "a computer telephone interface" is unclear if the first interface unit is a human operator or a telephone interface. The metes and bounds of the claims cannot be understood because of the lack of definiteness in the claims.

Id. at page 5. This rejection was first made in the Office Action mailed September 19, 2009, and Applicant responded as follows:

> Applicant respectfully submits that the first interface unit is claimed to be a human operator in dependent claim 3, and a processor in dependent claim 4. Since these claims are not dependent on each other, Applicant respectfully submits that the scope of each claim is clear. Further, Applicant submits that these claims comply with 35 U.S.C. § 112, second paragraph and respectfully request that these rejections be withdrawn.

Response filed December 7, 2007 at 11-12. The next Office Action (mailed February 26, 2008) indicated that this rejection was withdrawn because "Applicant has ... clarified claims" 3 and 4. Therefore, having already overcome this rejection, Applicant believes that this rejection is in error and requests that it be withdrawn.

D. <u>Claim Rejections under 35 U.S.C. § 103(a)</u>

Claims 1-31 stand rejected under 35 U.S.C. § 103 as allegedly rendered obvious by U.S. Patent No. 5,797,133 to Jones et al. ("Jones") in view of U.S. Patent No. 7,310,617 to Cunningham ("Cunningham"). Specifically, the Office Action asserts that Jones discloses all elements of the claims except for "the standards for the consumer pre-qualification [being] associated with financial institutions." Thus, the Office Action refers to Cunningham, which allegedly discloses "a method and system for presenting financial card offers to potential customers including the financial institution's selection standards." *Id.* at pages 6-8. Thus, the Office Action contends that:

> It would have been obvious to one of ordinary skill in the art at the time of the invention to include the financial institution selection criteria (or standards for consumer pre-qualification set by financial institutions) as taught by Cunningham into the automatic loan system/method for pre-approved or pre-qualified potential borrower as taught by Jones and as both Jones and Cunningham are direct[ed] toward the field of offering financial instruments (credit cards, loans) to potential pre-qualified/pre-approved consumers, no unpredicted results are expected.

Id. at page 8. Applicant continues to disagree, as the Office Action has failed to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, at least three criteria must be met. First, there must be some motivation or suggestion to make the proposed combination or modification of the references. Second, there must be a reasonable expectation of success. Finally, the combined or modified references must teach or suggest all claim limitations. *See* MPEP 2142 *et seq.*

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or "secondary considerations," of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). An "expansive and flexible approach" should be applied when determining obviousness based on a combination of prior art references. *KSR*, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. *Id.* at 1741. Rather, there must still be some "reason that would have

prompted" a person of ordinary skill in the art to combine the elements in the specific way that he or she did. *Id.*; *In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. *KSR*, 127 S. Ct. at 1740-41.

In the submission filed April 15, 2010, Applicant argued that neither Jones nor Cunningham disclosed "receiving information related to personal identification information associated with a consumer who is a customer of at least one of a financial institution and an entity associated with the financial institution, ***the consumer personal identification information being received prior to a consumer contact***," recited in independent claim 14. *See* Response filed April 15, 2010 at 12-13. In response, the Office Action disagrees, and cites the following passages of Jones in support:

> In accordance with one aspect of the instant invention, a method and associated apparatus is provided for determining the approval status of a potential borrower, ***including whether the potential borrower is pre-approved or pre-qualified for a loan***, in which unnecessary disclosure of sensitive information to persons, such as product dealers, regarding a potential borrower's ability to obtain a loan is not required.

Jones, Col. 2, ll. 43-50 (emphasis added).

> Preferred embodiments include automatically transmitting information regarding the approval status of the potential borrower to the lender and providing information regarding the lender's current interest rates to a remote location such as the office of the dealer.

Id., Col. 3, ll. 22-24.

> "Pre-approved" means that the borrower, except for verification of certain information, is approved for a loan of a specified amount.

Id., Col. 4, ll. 25-28. Based on these passages, the Office Action asserts that "the consumer information is received by the lender prior to [the] consumer mak[ing] a contact" and maintains the rejections. Office Action, Page 6.

Applicant submits that these passages do not disclose that the "consumer personal identification information [is] received prior to a consumer contact." Indeed, these passages provide no detail on Jones' preapproval process. Rather, when read in context, it is clear that any information received is received ***after*** the customer contacts the system.

Specifically, Jones discloses that the first step of its method is that the "potential borrower initiates a call on a tone generating telephone or other device" in order to start Jones' process. Jones, Col. 5, ll. 6-7. In response to questions, the customer can provide the customer's "social security number, address, birthdate, type of loan desired, amount of financing desired, cost of the item to be financed, the caller's monthly costs of living, total annual income, years at present job, and other questions designed to be inputted into a set of calculations to determine the creditworthiness of the borrower." *Id.*, col. 5, ll. 37-43. The data processor then accesses the credit bureau "using at least some predefined information ***received from the call*** ...." *Id.*, col. 5, l. 67 - col. 6, l. 1. Thus, according to Jones, it is necessary for the caller to provide information ***before*** the credit bureau can be accessed.

Jones then discloses that the data processor, "using the predetermined information and, preferably, the selected stored financial information regarding the potential borrower obtained from the credit bureau, ***then determines the approval status of the potential borrower*** according to criteria provided by a lender ...." *Id.*, col. 6, ll. 30-36. Clearly, as used by Jones, "preapproval" does not mean that "consumer personal identification information [is] received prior to a consumer

contact." Plainly, Jones discloses the exact opposite -- that customer contact is ***required*** before consumer personal identification information is received.

Therefore, Applicant maintains that Jones fails to disclose at least this element.

Moreover, in the prior submission, Applicant argued that Jones fails to disclose "receiving pre-qualification data from the third party w***herein the pre-qualification data relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database***." Although the Office Action did not respond to this argument, it continued to allege that this element is disclosed by Jones' disclosure of a credit bureau, this is not a disclosure of a "suppression database." The specification of the present application describes a "suppression database," according to one embodiment, as follows:

> In addition, the system or the third party may have a separate "suppression" database that includes information indicative of whether previously qualified consumers have, since prequalification, become unqualified for a financial instrument for any reason. ***Examples of information that may be maintained in the "suppression" database include the names of consumers who have opted out of sharing information for marketing purposes with credit bureaus or scorers; consumers that have recently responded to other offers of financial instruments by the financial institution; consumers whose credit lines with the financial institution have shifted recently; bankruptcy filings; or lower credit ratings due to increased debt or missed payments.*** This suppression database may also be checked prior to the offer of the financial instrument to the consumer. Alternatively to checking the suppression database in real time, the information in the suppression database may be periodically compared in batch operations to the consumer files holding the pre-qualification information, and a consumer's file or only certain pre-qualified offers in that consumer's file may be "flagged" to indicate it should be suppressed without altering the stored information in the file. The flag indicates that the consumer should not be offered one or more financial instruments.

Appl'n, Page 21, ll. 4-18 (emphasis added). Thus, using information about the customer to "extract stored financial information regarding the potential borrower from the data file of stored financial information in the credit bureau data processing system" is accessing a "suppression database."

Further, Applicant previously amended the claims to specifically claim the ***contents*** of the suppression database: "wherein the suppression database comprises a plurality of second consumer files, each of the second consumer files linked to a unique consumer identifier, wherein the second consumer files comprise suppression information relating to a determination that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file." Nowhere in Jones or Cunningham is a database including the claimed "second consumer files" -- files that contain ***suppression information*** -- disclosed. Indeed, all Jones discloses is determining the approval status based on predetermined information, selected stored financial information, and the lender's lending criteria. No "suppression information" is disclosed as being considered.

Therefore, the proposed combination of Jones and Cunningham fails to disclose this element, and Applicant respectfully requests that the rejection of claims 1-31 be withdrawn.

IV. CONCLUSION

Applicant respectfully submits that the application is in condition for allowance. Applicant believes that no fees are necessary in connection with the filing of this document. In the event any fees are necessary, please charge such fees, including fees for any extensions of time, to the undersigned's Deposit Account No. 50-0206. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,
HUNTON & WILLIAMS LLP

Dated: September 16, 2010

By: ______________________

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